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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,654	06/27/2001	Takashi Maruko	Q65201	5513

7590 09/21/2004  
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EXAMINER

DUONG, THANH P

ART UNIT PAPER NUMBER

1764

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/891,654

Applicant(s)

MARUKO ET AL.

Examiner

Tom P Duong

Art Unit

1764

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☒ The proposed amendment(s) will not be entered because:  
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: as stated in Final Rejection.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
10. ☐ Other: \_\_\_\_\_

  
Glenn Caldarola  
Supervisory Patent Examiner  
Technology Center 1700

The amendment filed on 8/19/04 which canceled claims 4 and 6 and then incorporated these limitations into claim 1 has been considered but not entered.

With respect to the argument of a melt index of at least 3.0 dg/min at 190°C, Sullivan discloses a multi-layer golf ball with a cover made of the same material (ionomer resins) with same Shore D hardness range as the claimed invention or the final golf ball product is the same as the claimed invention. Sullivan '831 is silent with respect to the melt index; however, such melt index parameter is an obvious processing parameter in the manufacturing of Sullivan's golf ball cover in order provide proper molding of the ball cover. In this case, there is no distinctive structural characteristics to the final golf ball cover product of the claimed invention versus Sullivan's golf ball cover. Note, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even through the prior product was made by a different process. In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 9666 (Fed. Cir. 1985).

With respect to the optimized equation,  $[(G1/(G1+G2)) \times 100 \geq 45\%]$ , Sullivan discloses the thickness range of the intermediate and outer cover layer of the claimed invention except the above optimized formula. However, the above G1 and G2 values are result-effective variables, which can be optimized thru routine experimentation to satisfy the above equation. See In re Antoine, 559 F. 2d 618, 195 USPQ 6 (CCPA 1977) and In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

With respect to the Shore D hardness of the intermediate layer, Sullivan does not disclose the Shore D hardness range; however, Shimosaka clearly teaches the importance of having an intermediate layer with Shore D hardness not less than 55 to provide a golf ball with a harder intermediate layer then the cover layer in order improved flight distance and softer feel. Thus, it would have been obvious in view of Shimosaka to one having ordinary skill in the art to fabricate the intermediate layer of Sullivan with a Shore D hardness range of Shimosaka in order to gain the above benefits.



Glenn Caldarola  
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